

## **R E M A R K S**

Claims 1-15, 17, 18 and 24-35 are presented for reconsideration.

In the Office Action, the specification was objected to, since the title was not descriptive of the invention; the Abstract was objected to; the Office Action stated that the applicants had not complied with one or more of the conditions for receiving the benefit of the earlier filing date under 35 USC 119(e); the drawings were objected to because of cross-hatching in Fig. 9; claims 1-15, 17, 18 and 24-35 were objected to for informalities; claims 1, 3, 4, 6, 7, 9, 13, 31 and 32 were rejected under the judicially-created doctrine of obviousness-type double-patenting on claims 1, 19-23 and 25-27 of U.S. Patent No. 6,229,975 (hereafter referred to as "the copending patent"); applicants note with appreciation that the subject matter of claims 2, 5, 8, 10-12, 14, 15, 17, 18, 24-30 and 33-35 were indicated as containing allowable subject matter and would be allowed if amended to be placed in independent form and to overcome the objections set forth in the Office Action.

Attached herewith in an envelope are 18 sheets of replacement sheets of drawings, which overcome the Examiner's objections to the cross-hatching, such as in Fig. 9, and incorporate the proposed drawing changes which were submitted to the Patent Office on or about April 15, 1999 and which change the Figure numbers for original Figs. 15, 16, 20 and 21. Also attached herewith are 18 annotated sheets of drawings, which indicate what has been changed in each of the replacement sheets of drawings.

By this amendment, a new Abstract has been submitted; a paragraph on page 9 of the specification has been amended to correct the misspelling of "collar" and claims 1, 3, 10, 12, 14, 24, 29 and 31 have been amended to overcome the Examiner's objections to these claims.

With regard to the Examiner's statement in Paragraph 4 on page 2 of the Office Action that applicants have not complied with one or more conditions for receiving benefit of the earlier filing date, it is submitted that this application was filed under the provisions of 35 USC 119(e) and that the sections of 37 CFR 1.78(a)(2) as well as 1.78(a)(5) are dealing with claiming benefit under 35 USC 120. Thus, it is submitted that since the Declaration identifies PCT Application PCT/DE97/02385 filed on October 15, 1997 and also the German priority document 196 42 570.0 of October 15, 1996, the requirements for benefit

under 35 USC 119(e) have been met. However, substitute page 1 of the translation has been amended to add a reference to the PCT and priority applications.

With regard to the rejection on double-patenting of claim 1 on the combination of claims 1, 19 and 27 of the copending patent, it is submitted that the device being claimed in claim 27 of the copending patent requires structure which is not present in claim 1. For example, means for generating a slight underpressure, said filling opening having a mouth adjacent the second opening for receiving the neck of a standardized toner bottle being inserted into said filling opening and the second opening as well as an apparatus cover for covering internal parts, electrical safety means and the second opening being provided in the apparatus cover-through which the toner reservoir can be refilled. It is submitted that claim 1 of the copending patent is directed to a different sub-combination of elements than what is recited by claim 1 of the present application. In other words, claim 1 of the present application is directed to a sub-combination of the full combination recited in claim 27 and it is submitted that the sub-combination of claim 1 of the present application is independent and distinct from the full combination of claim 27 of the copending patent. For example, the full combination of the copending patent depends on the allowability and patentability of original claim 1, which neither cites the elimination means of claim 19 or a controllable coupling of claim 27, which are both required by applicants claim 1. For these reasons, it is respectfully submitted that the rejection of claim 1 of the present application on the judicially-created doctrine of double-patenting is in error and should be withdrawn.

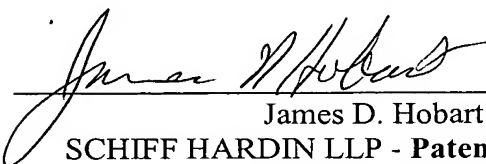
In view of the allowability of applicants' claim 2 and the amendment to claim 3 to be dependent on claim 2, it is respectfully submitted that the rejection of claims 3, 4, 6 and 7 on double-patenting are in error, since each of these claims require the structure of dependent claim 2, which was considered as being allowable over the teachings of the copending patent. With regard to the rejection of claim 9 on the grounds of double-patenting, it is submitted that claim 23, which is dependent on claim 19, is not dependent on claim 27 and, therefore, the combination of claims 1, 19 and 23 of the copending patent do not include the controllable coupling required in claim 9. In other words, claim 23 is not dependent on claim 27 and, thus, does not include the limitations of claim 27, which are the controllable coupling. For these reasons, it is respectfully submitted that the double-patenting rejection of claim 9 is in error and should be withdrawn.

In a similar manner, claim 13 also requires the controllable coupling, which is not present in the chain of claims 1, 19 and 25 and, thus, it is submitted that the rejection of claim 13 on double-patenting is in error and should be withdrawn.

With regard to the method claims, such as 31 and 32, it is submitted that the double-patenting rejection is in error. It is submitted that the method of operating the device recited in claims 31 and 32 of the present application is independent and distinct from the apparatus of claims 1, 19 and 27 and, therefore, the double-patenting rejection is in error and should be withdrawn.

In view of the amendments and explanations contained hereinabove, it is respectfully submitted that claims 1-15, 17, 18 and 24-35 are allowable and further reconsideration of the allowance of the application with these claims is earnestly solicited.

Respectfully submitted,

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450 on December 17, 2004.

James D. Hobart

Name of Applicants' Attorney



Signature

December 17, 2004

Date